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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/004,004

11/28/2001

Hiroshi Yamada

FUJI 19.210

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26304 7590 08/24/2007
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EXAMINER

HARRELL, ROBERT B

ART UNIT

PAPER NUMBER

2142

MAIL DATE

DELIVERY MODE

08/24/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/004,004

Applicant(s)

YAMADA, HIROSHI

Examiner

Robert B. Harrell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 May 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s).

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>see attached Office Action</u> |

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1. Claims 1-11 are presented for examination.
2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The claims now recite "dynamic" limitations.
3. The applicant should always use this period for response to thoroughly and very closely proof read and review the whole of the application for correct correlation between reference numerals in the textual portion of the Specification and Drawings along with any minor spelling errors, general typographical errors, accuracy, assurance of proper use for Trademarks TM, and other legal symbols [®], where required, and clarity of meaning in the Specification, Drawings, and specifically the claims (i.e., provide proper antecedent basis for "the" and "said" within each claim). Minor typographical errors could render a Patent unenforceable and so the applicant is strongly encouraged to aid in this endeavor.
4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
5. **Claims 1-7 are rejected under 35 U.S.C. 101** because the claimed invention is directed to non-statutory subject matter since such reads on (encompass) software or program per se' (In re Beauregard (CAFC) 35 USPQ2d 1383) and MPEP 2106 (New EXAMINATION GUIDELINES FOR COMPUTER-RELATED INVENTIONS). Even though drafted as "A device", the applicant's figure 4, as an example and non-limiting the claims, shows the device 32 as an "application" (i.e., software application). There is no suggest in the specification or figures that the application in figure 4 is other than software (i.e., hardware). The reason this rejection was not earlier presented is due to constant flux of Court precedence and modification of the Examination Guidelines.
6. The rejection, and grounds for rejection, under 35 U.S.C. 101 as presented in examiner's prior Office Action mailed 19 March 2007, are hereby maintained and incorporated in this Office Action by reference.

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7. The applicant argued in his 14 June 2007 response by stating in substance that examiner had cited to Fig. 4 of this instant application as allegedly showing that the rejected claims are directed to non-statutory subject matter. The applicant respectfully points out that Fig. 4 illustrates an ATM switching unit 30 that includes a switch part 31 and an application part 32. And the rejected claims recite interaction of various parts of a connection data change device with an associated switching unit, exemplary embodiments of which are illustrated in Fig. 4. In support the applicant cited to MPEP 2106.01(I) and portions of the Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility states of *R.A.C.C. Indus. v. Stun-Tech, Inc.*, 178 F.3d 1309 (Fed. Cir. 1998) (unpublished). However, examiner notes that the 1998 Court citation is "unpublished". With respect to claims 1-7 as being rejected under 35 U.S.C. 101, as argued by the applicant with respect to ATM switching unit 30, claims 1-7 need not encompass just the ATM switching unit 30, as is in claims 9-11, of this instant application, which were not equally rejected under 35 U.S.C. 101 since claims 9-11 stated "A switching unit" the very heading of element 30 in figure 4. Here, by the wording of "A switching unit", claims 9-11 encompasses the whole of figure 4, including physical hardware whilst claims 1-7 are broader to encompass only element 32 the "Application Part". "Application Part" is deemed, by common terminology in the Art for "Application", to mean software and/or programs. Also, "device", as recited in claim 1-7, need not be limited to "A hardware connection data change device" per se' but rather software devices and/or program devices (i.e., Titles of US 5794796 A, US 5873472 A, US 5896544 A, US 6339802 B1, as examples of common knowledge and terminology in the Art; not new as a bases for any rejection).

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this action:

A person shall be entitled to a patent unless -

(e) the invention was described in — (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international

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application designated the United States and was published under Article 21(2) of such treaty in the English language;

9 **Claims 1- 11 are rejected under 35 U.S.C. 102 (e)** as being by Chiu et al. (United States Patent Number: US 6,597,689).

10. Prior to addressing the grounds of the rejections below, should this application ever be the subject of public review by third parties not so versed with the technology (i.e., access to IFW through Public PAIR (as found on <http://portal.uspto.gov/external/portal/pair>)), this Office action will usually refer an applicant's attention to relevant and helpful elements, figures, and/or text upon which the Office action relies to support the position taken. Thus, the following citations are neither all-inclusive nor all-exclusive in nature *as the whole of the reference is cited* and relied upon in this action as part of the substantial evidence of record. Also, no temporal order was claimed for the acts and/or functions.

11. The rejections, and grounds for rejections, under 35 U.S.C. 102(e) as presented in examiner's prior Office Action mailed 19 March 2007, 27 October 2006, and 11 April 2006, are each hereby maintained and incorporated in this Office Action by reference.

12. The applicant argued in his 14 June 2007 response by stating in substance that Chiu only include description of releasing and setting up PVC's, and, therefore, fails to disclose the claimed feature of changing the type of a connection to an external switching unit in the connection data after the connection to the external switching unit is set up. The claimed invention provides for changing the connection type in the connection management data from a dynamic connection to a static connection, an exemplary embodiment of which is illustrated by step S40 in Fig. 7. And the claimed invention provides for storing the dynamic information set in the dynamic connection, an exemplary embodiment of which is illustrated by step S50 in Fig. 7. Thus, advantageously, the claimed invention provides for realizing an operation process at the time of a static connection change ... by an operation process at the time of a dynamic connection change, thus simplifying an operation at the time of a connection change (page 14 (lines 24-28 of the specification)).

However, there is no recital of an additional limitation of "static" as was the addition of "dynamic" within claims 1-11 as was recited by Chiu for dynamic per col. 4 (lines

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8-23), col. 8 (lines 45-48), col. 13 (lines 25-28), and col. 18 (line 52-et seq.), and per static per col. 4 (lines 7-38) and col. 18 (lines 52-et seq.). Hence, since the system of Chiu is accordingly changed over time, which requires storage of such changes, Chiu clearly taught and/or anticipated the claimed feature of changing the type of a connection to an external switching unit in the connection data after the connection to the external switching unit was set up. Therefore, Chiu also provided for changing the connection type in the connection management data from a "dynamic" connection to a "static" connection, and Chiu provided for storing the dynamic information set in the dynamic connection. Thus, advantageously, Chiu also provided for realizing an operation process at the time of a static connection change by an operation process at the time of a dynamic connection change, thus simplifying an operation at the time of a connection change.

13. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


14. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert B. Harrell whose telephone number is (571) 272-3895. The examiner can normally be reached Monday thru Thursday from 5:30 am to 2:00 pm.

16. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell, can be reached on (571) 272-3868. The fax phone number for all papers is (571) 273-8300.

17. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600.



ROBERT B. HARRELL
PRIMARY EXAMINER
GROUP 2142